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20151 7590 01/30/2008 HENRY M FEIEREISEN, LLC 350 FIFTH AVENUE SUITE 4714 NEW YORK, NY 10118			EXAMINER HEITBRINK, TIMOTHY W	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULRICH REICHSTEIN, OSWALD DACHS, GERD
WARNECKE, BODO STANGE and MATTHIAS KANTER

Appeal 2007-3364
Application 10/603,459
Technology Center 1700

Decided: January 30, 2008

Before CHUNG K. PAK, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1-4. We have jurisdiction under 35 U.S.C. § 6.¹

Appellants' invention relates to an injection molding machine wherein the machine control and the electric components are operatively connected

¹ An oral hearing was held on December 18, 2007.

in wireless mode. Representative independent claim 1, as presented in the Brief, appears below:

1. A machine of making molded articles of plastic or rubber, such as an injection molding machine, extruder or blow molding machine, comprising an internal machine control; and a plurality of internal electric components which are operatively connected through wireless communication to the machine control, wherein the machine control and the electric components have means for transmitting and receiving electromagnetic waves.

The Examiner relies on the following references in rejecting the appealed subject matter:

Latham	6,186,760	Feb. 13, 2001
Krause	DE 19909307	Sep. 23, 1999
Meschia	EP 1128244	Aug. 29, 2001
Abstract	DE 20204359U	Jun. 21, 2007

The Examiner entered the following rejections:

- I. Claims 1-4 stand rejected under 35 U.S.C. § 112, first paragraph, as not complying with the written description requirement.
- II. Claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.
- III. Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 102(b) as unpatentable over Latham.
- IV. Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as unpatentable over Krause, Meschia or the Abstract of DE ‘359.
- V. Claim 2 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Krause, Meschia or the Abstract of DE ‘359 and the admitted prior art.

The § 112, first paragraph rejection.

Claims 1-4 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the original specification in such a way as to reasonably convey that Appellants were in possession of the invention now claimed at the time of filing.

The issue presented is: Has the Examiner established that the subject matter of claims 1-4 does not meet the written description requirement of 35 U.S.C. § 112, first paragraph? We answer this question in the affirmative.

The Examiner contends that the Specification does not have written descriptive support for the subject matter of claims 1-4. Specifically, the Examiner contends that there is no support in the Specification for the term “internal” (internal meaning that the machine control and the electric components are incorporated in the same machine) (Answer 5).

Appellants contend that the originally filed disclosure conveys to one skilled in the relevant art the concept of wireless communication between the machine control and the electric components internally inside the injection molding machine. Appellants contend that support for the presently claimed invention can be found in paragraphs 0003, 0005, 0011, 0017 and 0018 of the specification and claim 4. (Br. 4-5).

Having reviewed the Appellants’ arguments and the portions of the specification relied upon therein, we determine that Appellants have not convinced us of a reversible error in the Examiner’s determination that the Specification does not contain written descriptive support for the claimed invention. Appellants have not established that they were necessarily in

possession of an injection molding machine comprising an internal machine control unit.

Regarding the discussion in paragraph 0003, Appellants assert “[t]his paragraph distinguishes between the parts of the injection molding machine, namely electric components and machine control and an external part, namely external computer. Thus, while not expressly referring to “‘internal’, it is [A]ppellants’ contention that this paragraph unambiguously implies that the electric components and the machine control are ‘internal’ parts.” (Br. 4). Paragraph 0003, as acknowledged by Appellants, does not expressly disclose that the machine control is internal to the injection molding machine. Nor is there any written description referred to by Appellants that would show the disclosure’s silence as to the location of the machine control unit as unambiguously implying the now claimed location of the machine control unit. Specifying one component to be external to the injection molding machine does not impliedly or necessarily indicate that all other components are internal to the injection molding machine. As such, this disclosure does not necessarily, impliedly, or expressly indicate that the machine control unit is internal to the injection molding machine.

Appellants’ reliance upon paragraph 0011 and claim 4 for written descriptive support is not persuasive. Paragraph 0011 and claim 4 disclose that at least one external device may be linked to the machine control in wireless mode. This disclosure does not indicate the absence of other external control devices. In other words, this disclosure allows for more than one external control devices. As such, this disclosure does not necessarily, impliedly or expressly indicate that the machine control unit is internal to the injection molding machine.

Paragraph 0005 does not support Appellants' contentions. This paragraph discloses the problems associated with the use of cables to connect electric components of an injection molding machine. This paragraph does not discuss the location of the machine control unit.

Paragraph 0017 does not support Appellants' contentions. This paragraph discusses Figure 1 which is described as a "schematic block diagram". Paragraph 0017 indicates that the electric components and the machine control are realized by wireless communication. However, Figure 1 and the description of the figure in paragraph 0017 do not indicate and/or show the location of the various electric components and the machine control unit of the injection molding machine. Thus, the description and the figure do not necessarily, impliedly or expressly indicate that the machine control unit is internal to the injection molding machine.

Paragraph 0018 describes the data communication utilized to transmit data to the machine controller. Paragraph 0018 does not indicate the location of the various electric components and the machine control unit of the injection molding machine. That is, the description does not necessarily, impliedly or expressly indicate that the machine control unit is internal to the injection molding machine.

An *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of Section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. *See In re Edwards*, 568 F.2d 1349, 1351-352 (CCPA 1978). Consistent with these principles of law, the Examiner has shown by a preponderance of evidence that Appellants are

claiming embodiments of the invention that are completely outside the scope of the disclosure as originally filed. *See In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996). Appellants' arguments, however, have not overcome this prima facie case.

Therefore, we affirm the Examiner's rejection of claims number 1-4 under 35 U.S.C. § 112, first paragraph.

The § 112, second paragraph rejection.

The issue presented is: Has the Examiner established that the subject matter of claims 1-4 does not meet the requirements of 35 U.S.C.

§ 112, second paragraph? We answer this question in the negative.

The Examiner contends that the subject matter of claims 1-4 is indefinite in scope because "[t]he added limitation of 'internal' renders the claims indefinite since it is unclear in what relation the machine control and electric components are internal, internal to the machine, internal to the room, etc..." (Answer 3).

"The legal standard for definiteness [under the second paragraph of 35 U.S.C. § 112] is whether a claim reasonably apprises those of skill in the art of its scope" *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). The inquiry is to determine whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. The definiteness of the language employed in a claim must be analyzed not in a vacuum, but in light of the teachings of the particular application. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

After consideration of the present record, we determine that a person of ordinary skill in the art would have realized that the disputed claim language

requires that the machine control unit and electric components are internal to the injection molding machine as specified in independent claim 1.²

New Ground of Rejection

We exercise our authority pursuant to 37 C.F.R. § 41.50(b) to enter a new ground of rejection against claims 1 through 4 under 35 U.S.C. § 112, second paragraph:

Claim 1 utilizes the phrase “A machine of making molded articles of plastic or rubber, such as an injection molding machine, extruder or blow molding machine”. This language leads to confusion over the intended scope of the claims on appeal. Specifically, it is not clear whether the “such as” language is intended to narrow the claimed machines solely to those specified.

Moreover, we find no structure in the specification corresponding to the claimed means-plus-function language consistent with 35 U.S.C. § 112, sixth paragraph. As such, it is not clear what structure is included by the claimed means-plus-function language.

Accordingly, we determine that the metes and bounds of claims 1 through 4 are not clearly set forth as required by 35 U.S.C. § 112, second paragraph.

² The determination that the claimed subject matter is not supported by the original specification does not necessarily lead to the conclusion that the claimed subject matter is indefinite.

The Prior Art Rejections.

We now turn to the prior art rejections. For purposes of these rejections, we will conditionally interpret the ambiguous language in question as being limited to “an injection molding machine, extruder or blow molding machine” in the interest of administrative and judicial economy. *See Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993); *Ex parte Ionescu*, 222 USPQ 537, 540 (BPAI 1984). We note that independent claim 1 requires the machine control unit to be internal to the injection molding machine. Thus, the prior art cited in the rejections under §102 must describe an injection molding machine comprising an internal machine control unit.

The issue before us is whether the Examiner has properly determined that the Latham, Krause, Meschia or the Abstract of DE ‘359 teaches or describes the claimed subject matter under 35 U.S.C. §102(b). Specifically, the issue is whether the Examiner has properly determined that Latham, Krause, Meschia or the Abstract of DE ‘359 describes an injection molding machine that internally comprises the machine control and electric components as specified in independent claim 1? We answer this question in the negative.

Appellants argue, and the Examiner has not refuted, that Latham, Krause, Meschia or the Abstract of DE ‘359 describes a system for monitoring and controlling a blow molding machine using wireless communication between the machine and a computer at a remote (external) site (Br. 7-9). The Examiner has not carried the burden of making out a prima facie case of anticipation in the first instance by pointing out where each and every limitation of the claimed invention is arranged as required by the independent claim, is described identically in the references, either

expressly or under the principles of inherency. It appears that the Examiner is relying upon the claim interpretation that the injection molding machine and the machine control are located within something. (Answer 6). This interpretation of the claimed subject matter is not appropriate. The claimed subject matter is directed to an injection molding machine internally comprising the machine control and electric components. Not to an injection molding machine and machine control are located within something, such as a room, as suggested by the Examiner. The stated rejections are reversed

As to the Examiner's rejection of claim 2 under 35 U.S.C. § 103, we note that the Examiner has not provided a proper claim interpretation for the limitations recited in independent claim 1. Since claim 2 encompasses the limitations recited in the independent claim, we determine that the Examiner's analysis lacking any discussion of such limitations is incomplete. As such, the rejection of claim 2 under 35 U.S.C. § 103 as obvious over the cited prior art is reversed.

Other Issues

The Examiner has included the Abstract of DE '359 in rejecting some of the claims on appeal. During the oral hearing, Appellants' representative indicated that the publication date of the DE '359 reference was incorrect. In the event of further prosecution, the Examiner should ensure the Abstract of DE '359 and/or the DE '359 reference itself is appropriate prior art before applying it to reject the claimed subject matter.

Conclusion

The Examiner correctly rejected claims 1-4 under 35 U.S.C. §112, first paragraph. The Examiner erred in rejecting claims 1, 3, and 4 under 35 U.S.C. §102(b), claim 2 under 35 U.S.C. §103(a), and claims 1-4 under 35 U.S.C. §112, second paragraph. Pursuant to the provisions of 37 CFR §41.50 (b), we enter a new ground of rejection against claims 1-4 under 35 U.S.C. §112, second paragraph.

ORDER

The rejection under 35 U.S.C. §112, first paragraph is AFFIRMED. The rejection under 35 U.S.C. §112, second paragraph is REVERSED. A new rejection against claims 1-4 under 35 U.S.C. § 112, second paragraph, is ENTERED. The rejections under 35 U.S.C. §§102 and 103 are REVERSED.

In view of the forgoing, the decision of the Examiner is affirmed and a new ground of rejection is entered against claims 1-4 under 35 U.S.C. § 112, second paragraph.

1 Regarding the affirmed rejection(s), 37 C.F.R. §41.52(a)(1) provides "Appellant[s] may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. §41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the Application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

Appeal 2007-3364
Application 10/603,459

AFFIRMED/ 37 CFR § 41.50 (b)

tc

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